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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/127,316	07/31/1998	TA YEN CHING		9973

7590 05/28/2004

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EXAMINER

NOLAN, SANDRA M

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 05/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/127,316

Examiner

Sandra M. Nolan

Applicant(s)

CHING ET AL.

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2004 and 12 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 99-139, 141-180, 182, 183 and 186-194 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 107-139, 141-180, 182, 183 and 186-194 is/are allowed.
- 6) ☒ Claim(s) 99-106 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12 Apr 2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claims***

1. Pursuant to entry of the amendment in the 23 February 2004 response, claims 99-139, 141-180, 182-183 and 186-194 are pending.
2. Claims 1-98, 140, 181, and 184-185 have been cancelled.

### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on 12 April 2004 was considered by the examiner. One of the new grounds of rejection stated below is based upon a reference cited therein.

### ***Withdrawal of Allowance***

4. The allowance of claims 99-106 is hereby withdrawn in order to apply the new rejections set out below.

### ***Allowable Subject Matter***

5. Claims 107-139, 141-180, 182-183 and 186-194 are allowed. See the reasons for allowance in the 01 December 2003 office action.

Note: The examiner finds the phrases "wherein P+T+Q is 100 mol% of the total composition" and "P, T, and Q are each greater than 0 mol% of the total composition" cumbersome. Nonetheless, she is willing to permit the language because it appears to mean that none of P, T, or Q is zero and the sum of P, T and Q is such that the links make up 100% of all mole fractions of the compound.

The examiner interprets "of the total composition" to mean "of the total compound" in claims 107-139, 141-180, 182-183 and 186-194. See section 8 below.

***Objections Withdrawn***

6. The objections to claims 184 and 185 for double patenting over claims 99 and 106, stated in sections 5-7 of the 01 December 2003 office action, are withdrawn in view of the cancellation of claims 184 and 185 in the response dated 23 February 2004.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 99-106 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 99 recites the limitation "of the total composition" in the second line after the polymer formula. There is insufficient antecedent basis for this limitation in the claim. Claims 99-106 are drawn to compounds, not compositions.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 99, 100 and 105 are rejected under 35 U.S.C. 102(b) as being anticipated by Tellier et al (US 3,632,684). Tellier was cited in applicants' IDS of 12 April 2004.

Art Unit: 1772

Tellier shows copolymers containing units derived from styrene (col. 3, lines 37, 48, and 54), alkyl acrylates (col. 3, lines 28-30), and methylcyclohexyl (meth)acrylates (col. 3, lines 46-47). Note the structure in the abstract.

These copolymers anticipate the compounds recited in claims 99, 100 and 105.

**Conclusion**

Any inquiry concerning this communication should be directed to Sandra M. Nolan, whose telephone number is 571/272-1495. She can normally be reached on Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time.

If attempts to reach the examiner are unsuccessful, her supervisor, Harold Pyon, can be reached at 571/272-1498.

The fax number for patent application documents is 703/872-9306.



S. M. Nolan  
Primary Examiner  
Technology Center 1700

SMN/smn  
09127316(20040524)

**SANDRA M. NOLAN**  
**PRIMARY EXAMINER**